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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Inventors: James Richard Jackson Art Unit: 1641
Serial No.: 09/381,561 Examiner: C. Chin
Filed: September 17, 1999
For: RECORDING ASSAY DEVICE

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted via
facsimile to the ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON,
D.C. 20231 on May 13, 2002.

Stephen Gigante, Reg. No. 42,576
Name of Registered Representative)

[Signature] 5/13/02
(Signature and Date)

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

ASSISTANT COMMISSIONER FOR PATENTS
BOX AF
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In response to the Final Rejection dated February 1, 2002, the Applicant, who previously filed a Notice of Appeal on April 30, 2002, respectfully request reconsideration of the Final Rejection for the following reasons:

Applicant notes with appreciation that the all grounds of rejection under 35 U.S.C. §112 have been withdrawn.

(1) With regard to the rejection of claims 20-39 under 35 U.S.C. §102(e) over Chow, it is respectfully submitted that instant claim 20 recites an assessment device comprising an assay part and a detachable recording part, wherein the recording part only

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records assay information without analyzation thereof for subsequent processing and analysis at a remote data processing site.

In response to Applicant's arguments, it was indicated in the final rejected that we were arguing use, as opposed to structure. Applicant respectfully submits that the "use" argument was made to show that the claimed elements are not the same in the instant invention and Chow.

It is respectfully submitted that Chow does not disclose a detachable recording part, as presently claimed. The sample substrate portion disclosed by Chow receives "a sample and processes the sample in some manner to provide a detectable output which can be related to a sample characteristic" (column 8, lines 52 to 58). Applicant respectfully submits that the aforementioned teaching of Chow does not anticipate a claim (claim 20) reciting, *inter alia* that the "recording part only records the assay information without analyzation thereof", as recording is clearly distinguishable from analyzing and processing. Claim 20 also recites that the processing is performed *subsequently* at a remote site, which is different from the processing by the sample substrate, as disclosed by Chow.

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For at least the reasons in the above paragraph, none of the instant claims are anticipated by Chow as this reference fails to disclose, *inter alia*, a detachable recording part that "only records the said assay information without analyzation thereof" (negative limitation).

In order for a reference to anticipate under 35 U.S.C. §102, each and every claimed element must be found in a single prior art reference.

In addition, the Court of Appeals for the Federal Circuit held in *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987):

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

As for the reasons previously indicated, the Office Action fails to set forth each and every claimed element in a single reference. Reconsideration and withdrawal of this ground of rejection are respectfully requested.

(2) With regard to the rejection of claims 20-39 under 35 U.S.C. §103(a), it is respectfully submitted that the combination of references fails to provide disclosure, suggestion, or motivation

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that would have made any of the instant claims obvious to a person of ordinary skill in the art with knowledge of the combination of references.

The Final Rejection references previous Office Actions that alleged that neither Hillman discloses a recording part in communication with an assay device. However, Applicants, while agreeing with the aforementioned statement regarding Hillman, further submits that neither Galen or Phillips discloses a detachable recording part, which only records the assay information without analyzation thereof in a form suitable for onward transmission for subsequent processing and analysis at a remote processing site. Galen merely shows a glucose strip in which a light is shown through and a detected by a detector. There is no teaching in Galen that the recording part is detachable, nor that it provides subsequent processing and analyzation. Phillips similarly fails to disclose, suggest, or motivate an artisan to provide a detachable recording part as instantly claimed.

One of the reasons mentioned in the instant specification is that there can be a problem with tampering of a testing device if there is analyzation and processing at the detachable recording part. The advantage is that at a remote site the recording data

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can be analyzed more securely and inexpensively than by the teachings of the combination of references. The present invention allows analysis to be performed inexpensively at remote processing centers, and provides a relatively inexpensive diagnostic tool. The combination of references fails to disclose, suggest, or motivate an artisan so that the instant claims would have been obvious to the artisan in view thereof.

Applicant notes that it was held by the Court of Appeals in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992) that:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In the present case, it is respectfully submitted that the teachings of the combination of references do not overcome the standard of establishing obviousness as exemplified in *Fritch*, as

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the Final Rejection and previous Office Actions fail to provide a *prima facie* case of obviousness. Reconsideration and withdrawal of this ground of rejection are respectfully requested.

For all the foregoing reasons, it is respectfully submitted that none of the present claims are anticipated by Chow because the reference fails to disclose or suggest all of the elements recited in the present claims. Reconsideration and withdrawal of this ground of rejection are respectfully requested.

Therefore, it is respectfully submitted that the present claims would not have been obvious to a person of ordinary skill in the art over the combination of the cited references, because the combination fails to disclose or suggest to an artisan all of the features recited by the present claims.

Reconsideration and withdrawal of this ground of rejection are respectfully requested.

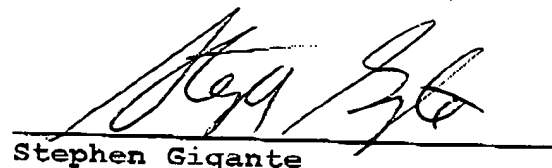
In light of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and a notice to that effect is respectfully solicited.

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If any issues remain which may best be resolved through a telephone communication, the Examiner is requested to kindly telephone the undersigned at the telephone number listed below.

Respectfully submitted,



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Date: May 13, 2002

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